

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	Application No. 09/922,935)	<i>Confirmation No. 9732</i>
Filed:	August 7, 2001)	
)	
Applicant:	James G. GATTO)	
Title:	ELECTRONIC FUND TRANSFER OR TRANSACTION SYSTEM)	
Art Unit:	2887)	
Examiner:	Karl D. FRECH)	
)	
Patent No.:	US 7,661,590 B1)	
Issued:	February 16, 2010)	
)	
Attorney Docket:	94512)	This Petition For Reconsideration Of Patent Term Adjustment was electronically filed on June 16, 2010 using EFS-Web.
Customer No.:	22242)	

Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

**PETITION FOR RECONSIDERATION
OF PATENT TERM ADJUSTMENT**

Sir:

Reconsideration is respectfully requested of the Patent Term Adjustment for the above-identified application. U.S. Patent No. 7,661,590 B1, issued on February 16, 2010, indicates that the term of the patent "is extended or adjusted under 35 U.S.C. § 154(b) by 1200 days." A Request For Recalculation of Patent Term Adjustment in View of *Wyeth* was submitted on February 17, 2010. The Request for Recalculation was granted in a first Decision mailed on April 21, 2010, indicating that "[t]he patent term has been determined to be

274 days.” A second Decision vacating the first Decision was mailed on May 18, 2010 indicating that “[t]he patent term adjustment has been determined to be 306 days.” The second Decision further indicates that the USPTO will afford the patentee an opportunity to be heard and request reconsideration of this patent term adjustment calculation by filing an application requesting reconsideration under 35 U.S.C. § 154(b)(3)(B)(ii) within one month or thirty (30) days, whichever is longer. Applicant respectfully submits that the Patent Term Adjustment should be 753 days under 37 C.F.R. §§ 1.703-1.705 and 35 U.S.C. § 154(b) and not 306 days as indicated in the second Decision on Request For Recalculation of Patent Term Adjustment in *View of Wyeth*.

The present application was filed on August 7, 2001. As supported by the attached AIPA Term Calculation Report, the Applicant should be credited the following days:

1. On December 27, 2005, a Response after Ex Parte Quayle Action under 37 C.F.R. § 1.113(c) was filed by the Applicant. The next action entered by the USPTO was a Notice of Allowance under 35 U.S.C. § 151 on September 3, 2009. Under 37 C.F.R. § 1.703(a)(2), the period of adjustment is equal to the number of days in the period beginning the day after the date that is four months after the date of a reply under § 1.111 and ending on the day of either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151, whichever occurs first. The period between April 28, 2006 (the day after four months after the date of reply) and September 3, 2009 is 1,225 days (see Row P, page 6).
2. On February 9, 2007, an Interference under 35 U.S.C. § 135(a) was declared with respect to the application. On August 23, 2007, the Interference under 35 U.S.C. § 135(a) was terminated with respect to the application. Under 37 C.F.R. § 1.703(c)(1), the period of adjustment is equal to the number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was

terminated with respect to the application. The period between February 9, 2007 and August 23, 2007 is 196 days (see Row R, page 6).

3. As previously noted, on August 23, 2007, the Interference under 35 U.S.C. § 135(a) was terminated with respect to the application. The next action entered by the USPTO was a Notice of Allowance under 35 U.S.C. § 151 on September 3, 2009. Under 37 C.F.R. § 1.703(a)(5), the period of adjustment is equal to the number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. § 141 or a civil action under 35 U.S.C. §§ 145 or 146 where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151, whichever occurs first. The period between December 24, 2007 (the day after four months after the date of termination of the Interference) and September 3, 2009 is 620 days (see Row S, page 7).

The total number of days of credit in Paragraphs 1, 2, and 3 equals 2,041 days (see Total Credit Days, page 8). However, the entire periods listed in Paragraphs 2 and 3, which total 816 days (see Credit Overlap Days, page 8), are overlapped by the period listed in Paragraph 1. Therefore, the net number of credit days equals 1,225 days (see Net Credit Days, page 8).

As supported by the attached AIPA Term Calculation Report, the following “Exclusion” days are indicated:

4. The Three-Year PTO Issue Requirement under 35 U.S.C. § 154(b)(1)(B)(i) does not include the period consumed by continued examination of the application under 35 U.S.C. § 132(b). Due to the filing of a first Request for Continued Examination (RCE) under 35 U.S.C. § 132(b) filed on April 26, 2004, the AIPA Term Calculation

Report lists 2,123 Exclusion Days which includes the period between the filing of the first RCE and the issue date of February 16, 2010 (see Row I, page 4).

5. The Three-Year PTO Issue Requirement under 35 U.S.C. § 154(b)(1)(B)(i) does not include the period consumed by continued examination of the application under 35 U.S.C. § 132(b). Due to the filing of a second RCE under 35 U.S.C. § 132(b) filed on October 28, 2004, the AIPA Term Calculation Report lists 1,938 Exclusion Days which includes the period between the filing of the second RCE and the issue date of February 16, 2010 (see Row L, page 5).
6. The Three-Year PTO Issue Requirement under 35 U.S.C. § 154(b)(1)(B)(ii) does not include the period consumed by an Interference beginning on the date the Interference was declared or redeclared and ending on the date the Interference was terminated. The AIPA Term Calculation Report lists 196 Exclusion Days which includes the period between the date the Interference was redeclared on February 9, 2007 and ending on the date the Interference was terminated on August 23, 2007 (see Row Q, page 6).

The total number of days of Exclusion listed in Paragraphs 4, 5, and 6 equals 4,257 days (see Total Exclusion Days, page 8). However, the entire periods listed in Paragraphs 5 and 6, which total 2,134 days (see Exclusion Overlap Days, page 8), are overlapped by the period listed in Paragraph 4. Therefore, the net number of credit days equals 2,123 days (see Net Exclusion Days, page 8). Due to the first RCE being filed prior to the date that is three years following the filing date of the application, there is no patent term adjustment available under 35 U.S.C. § 154(b)(1)(B) which is reflected in the listing of the Exclusion Days running from the date of the first RCE to the date of issuance of the patent.

As supported by the attached AIPA Term Calculation Report, the following Applicant Delay or "Debit" days are indicated:

7. A Final Rejection was mailed on March 25, 2003. The Applicant filed a Notice of Appeal in response to the Final Office Action on September 25, 2003. According to 37 C.F.R. § 1.704(b), the period of adjustment shall be reduced for the period in excess of three months taken to reply to any PTO notice or action beginning on the day after the date that is three months after the mailing of the Office communication and ending on the date the reply was filed. The period between June 26, 2003 (the day after the date that is three months after the mailing) and September 25, 2003 equals 92 days (see Row H, page 4).
8. On April 26, 2004, the Applicant filed an RCE and on July 26, 2004, the Applicant filed an Information Disclosure Statement. Under 37 C.F.R. § 1.704(c)(8) the period of adjustment shall be reduced where the Applicant submits a supplemental reply not expressly requested by the Examiner after a reply has been filed, for the period beginning on the day after the date the initial reply was filed and ending on the date that the supplemental paper was filed. The period between April 26, 2004 and July 26, 2004 equals 91 days (see Row J, page 4).
9. On January 27, 2005, an Ex Parte Quayle Action was mailed. On December 27, 2005, a response that was fully responsive to the Ex Parte Quayle Action was entered. Under 37 C.F.R. § 1.704(b), the period of adjustment shall be reduced for the period in excess of three months taken to reply to any PTO notice or action beginning on the day after the date that is three months after the mailing of the Office communication and ending on the date the reply was filed. The period between April 28, 2005 (the day after the date that is three months after the mailing) and December 27, 2005 equals 244 days (see Row M, page 5).
10. On July 26, 2005, a Response having an omission was entered by the Applicant. On December 27, 2005, a response that was fully responsive to the Ex Parte Quayle Action was entered. Under 37 C.F.R. § 1.704(c)(7), the period of adjustment shall

be reduced where the Applicant submits a reply having an omission, for the period beginning on the day after the date the reply having an omission was filed and ending on the date that the reply correcting the omission was filed. The period between July 27, 2005 (the day after the date the reply with the omission was filed) and December 27, 2005 equals 154 days (see Row N, page 5).

11. An Amendment after Notice of Allowance under 37 C.F.R. § 1.312 was filed on December 2, 2009 and a Response to the Amendment after Notice of Allowance was mailed on January 15, 2010. Under 37 C.F.R. § 1.704(c)(10), the period of adjustment shall be reduced where the Applicant submits an amendment under 37 C.F.R. § 1.312, for the period beginning on the date the amendment was filed and ending on the mailing date of the response. The period between December 2, 2009 and January 15, 2010 equals 45 days (see Row U, page 7).

The total number of days of debit in Paragraphs 7 to 11 equals 626 days (see Total Debit Days, page 8). However, the entire period listed in Paragraph 10, which totals 154 days (see Debit Overlap Days, page 8) is overlapped by the period listed in Paragraph 9. Therefore, the net number of debit days equals 472 days (see Net Debit Days, page 8).

Based on the above information, the Applicant asserts that the correct amount of patent term adjustment that should be granted in this case should be 753 days which is equal to the net number of credit days (1,225) reduced by the net number of debit days 472. 35 U.S.C. § 154; 37 C.F.R. §§ 1.702-1.704.

This patent is not subject to a terminal disclaimer.

This Petition For Reconsideration Of Patent Term Adjustment Application is filed within one month or thirty (30) days of the Decision and, thus, Applicant submits that this Petition is timely filed.

Authorization to charge Deposit Account No. 06-1135 for the fee under 37 C.F.R. § 1.18(e), according to 37 C.F.R. § 1.705(d) and 37 C.F.R. § 1.705(b)(1), was given using EFS-Web.

Application No. 09/922,935
PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT dated June 16, 2010
Reply to Decision of May 18, 2010
Patent No. US 7,661,590 B1, Issued February 16, 2010
Attorney Docket 94512

The Commissioner is hereby authorized to charge any additional fees which may be required with respect to this communication, or credit any overpayment, to Deposit Account No. 06-1135.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY

Dated: June 16, 2010

/Nicholas T. Peters/
Nicholas T. Peters
Registration No. 53,456
ntpete@fitcheven.com

120 South LaSalle Street, Suite 1600
Chicago, Illinois 60603-3406
Telephone (312) 577-7000
Facsimile (312) 577-7007
561115

Appendix: AIPA Term Calculation Report